

**REMARKS**

In the Final Office Action mailed October 8, 2004, the Examiner rejected claims 1-8, 77-82, and 91-96 under 35 U.S.C. § 112, second paragraph as being indefinite. The Examiner also rejected claims 1-8, 77-82, and 91-96 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,025,475 to *Okabe* ("Okabe").

By this amendment, Applicants have amended claims 1, 77, and 91 without prejudice or disclaimer. Applicants have also canceled without prejudice or disclaimer claims 9-76, 83-90, and 97-158, previously non-elected without traverse. Accordingly, claims 1-8, 77-82, and 91-96 remain pending.

**Claim Rejections Under 35 U.S.C. § 112**

As an initial matter, the Examiner withdrew the previous rejections under 35 U.S.C. § 112. However, the Examiner has now taken the following position: "[I]t is noted that the processing step, wherein mailpieces are processed if no code is found on either surface, is a *conditional* step. That is, if a code is found on either surface and the mail is sorted based on said code, the conditional step is not unnecessary [sic], as the claim has already been anticipated." Office Action, Page 2.

Applicants respectfully disagree with the Examiner's interpretation. The Examiner is essentially attempting to justify ignoring certain claimed processing limitations, *i.e.*, the Examiner takes the position that certain limitations are absent when the mailpiece includes neither a code on the front of the mailpiece nor a code on the back of the mailpiece ostensibly because it is a "conditional step." Relying on this erroneous interpretation, the Examiner concludes that "the conditional step need not be

present in the prior art to anticipate the claimed invention if the prior sorting conditions have been properly fulfilled.” Office Action, Page 2.

Applicants respectfully submit that the Examiner cannot ignore this limitation – even if “conditional.” Independent claim 1 recites three distinct method limitations that must occur if certain conditions are met. Each limitation has its own unique condition. Thus, all three limitations are conditional in that each limitation will not be performed unless a certain condition is met. For example, claim 1 recites in pertinent part:

- (1) sorting the mailpiece using a code on the front of the mailpiece, if it was determined that the mailpiece includes a code on the front of the mailpiece;
- (2) identifying the mailpiece using a code on the back of the mailpiece, if it was determined that the mailpiece includes a code on the back of the mailpiece only; and
- (3) processing the mailpiece in an identification code system if it was determined that the mailpiece includes neither a code on the front of the mailpiece nor a code on the back of the mailpiece processing the mailpiece in the identification code system comprising: applying an identification code to the back of the mailpiece, applying a postal code to the front of the mailpiece in accordance with the destination information on the mailpiece, and creating an identification file corresponding to the identification code, wherein the

identification file is accessible by a plurality of nodes in the identification code system.

The Examiner's attention is directed to Applicants' use of the term "and" between limitations (2) and (3) above. Thus, claim 1 does not recite only two method steps as the Examiner seems to suggest, but rather claim 1 recites all three conditional limitations. Put another way, all claimed conditional method limitations must be present in the prior art even if the prior art discloses -- and even meets -- only some of the conditional method limitations. "The identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Next, the Examiner rejected claims 1-8, 77-82, and 91-96 under 35 U.S.C. § 112, second paragraph as being indefinite. Although Applicants do not agree that the phrase "may be" in the independent claims renders the claims indefinite as the Examiner alleges, Applicants have nevertheless changed the phrase "may be accessed" to "is accessible" in independent claims 1, 77, and 91 to address the Examiner's concerns. Applicants respectfully submit that this amendment does not narrow the scope of the claims and is not for reasons related to patentability. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

### **Claim Rejections Under 35 U.S.C. § 102**

#### **The Rejection of Claims 1-8, 77-82, and 91-96 Under 35 U.S.C. § 102(b) As Being Anticipated by Okabe.**

In the Office Action, the Examiner rejected claims 1-8, 77-82, and 91-96 under 35 U.S.C. § 102(b) as being anticipated by *Okabe*. For the reasons set forth below, however, Applicants respectfully request that the Examiner withdraw the rejection.

In order to properly establish that a prior art reference anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The cited reference, *Okabe*, however, does not disclose each and every element of the claims as required by § 102.

*Okabe* discloses a mail processing machine comprising: (a) means for feeding a piece of mail having first and second surfaces; (b) first detecting means for detecting the presence of an address on the first surface of the piece of mail; (c) second detecting means for detecting the presence of an address on the second surface of the piece of mail; (d) means for determining a front side of the piece of mail on which the address is detected to be present; (e) third detecting means for detecting an address on the first surface of the piece of mail, when the first surface is determined as the front side; (f) fourth detecting means for detecting an address on the second surface of the piece of mail, when the second surface is determined as the front side; and (g) means for

recognizing content of the address detected by one of the third and the fourth detecting means. See col. 1, lines 38-55.

Applicants respectfully submit that *Okabe* does not disclose, among other things, the following limitations of claim 1:

processing the mailpiece in an identification code system if it was determined that the mailpiece includes neither a code on the front of the mailpiece nor a code on the back of the mailpiece, processing the mailpiece in the identification code system comprising: applying an identification code to the back of the mailpiece, applying a postal code to the front of the mailpiece in accordance with the destination information on the mailpiece, and creating an identification file corresponding to the identification code, wherein the identification file is accessible by a plurality of nodes in the identification code system.

As noted previously, Applicants respectfully submit that the Examiner cannot ignore all claimed limitations – even if “conditional.” Independent claim 1 recites three distinct method limitations that must occur if certain conditions are met. Each limitation has its own unique condition. Thus, all three limitations are conditional in that each limitation will not be performed unless a certain condition is met. For example, claim 1 recites in pertinent part:

(1) sorting the mailpiece using a code on the front of the mailpiece, if it was determined that the mailpiece includes a code on the front of the mailpiece;

(2) identifying the mailpiece using a code on the back of the mailpiece, if it was determined that the mailpiece includes a code on the back of the mailpiece only; and

(3) processing the mailpiece in an identification code system if it was determined that the mailpiece includes neither a code on the front of the mailpiece nor a code on the back of the mailpiece processing the mailpiece in the identification code system comprising: applying an identification code to the back of the mailpiece, applying a postal code to the front of the mailpiece in accordance with the destination information on the mailpiece, and creating an identification file corresponding to the identification code, wherein the identification file is accessible by a plurality of nodes in the identification code system.

As noted previously, to properly anticipate, the prior art reference must disclose each and every element of the claims as required by § 102. Therefore, all three claimed conditional limitations noted above must be present in the prior art to anticipate the claims. Applicants respectfully submit that *Okabe* does not disclose at least limitation (3) above. For at least this reason, the Examiner's rejection under § 102(b) is improper and must be withdrawn.

Similarly, independent claims 77 and 91 contain commensurate limitations and are allowable over *Okabe* for at least the same reasons.

Therefore, independent claims 1, 77, and 91, as well as all claims depending therefrom, are allowable over *Okabe*.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

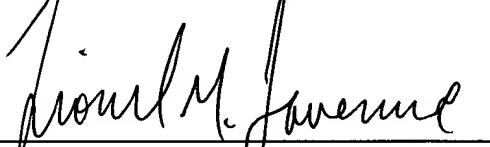
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 8, 2005

By: \_\_\_\_\_

  
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